

REMARKS

Entry of this amendment is respectfully requested. No new matter is added by the amendment, because the new claims are supported by the present application as filed and by US Application No. 09/579,279 (now US Patent No. 6,458,998), which is incorporated into this application by reference. A more detailed discussion of the amendment and its support is found below.

Claims 21-36 are in this application, claims 1-20 having been cancelled and claims 21-36 having been added by this amendment.

Claims 1-20 were subject to a restriction requirement, and claims 1-2 (in part), 12-17 (in part), 6-11, 19, and 20 were withdrawn from consideration. The specification was objected to under 35 USC 112 for improper incorporation by reference, claims 3-5 were rejected under 35 USC 112, ¶1, and claims 1-5 and 12-18 (to the extent examined) were rejected for obviousness-type double patenting over claims 29-33 of US Patent No. 6,458,998, with the Examiner noting that the rejection could be overcome by the filing of a terminal disclaimer.

The restriction requirement has been complied with; and the objection to the specification and the rejections are respectfully traversed in view of the amendment and the accompanying terminal disclaimer.

The amendment

As mentioned above, the new claims are supported by the application as filed and by US Application No. 09/579,279 (the "279 application"), now US Patent No. 6,458,998 (the "998 patent"), which is incorporated into this application by reference, at page 3, lines 28-29.

Specifically, claim 21 is supported by claim 3 of the application as filed, with the definition of Y being supported by the '279 application at page 17, lines 7-10 (column 10, lines 15-18 of the '998 patent); claim 22 is supported by the compound disclosure at page 19, lines 16-24 of the '279 application (column 11, lines 47-67 of the '998 patent); claims 23 and 24 are supported by the compound disclosure at claims 13 and 14 of the '279 application (claims 8 and 9 of the '998 patent); and claims 25-28 are supported by the compound disclosure at claims 17 (both occurrences – there is a second claim 17 following claim 20 in the application as filed before PTO renumbering of the claims), and 20-22 of the '279 application (claims 13 and 16 together, and claims 17-19 of the '998 patent).

Claim 29 is claim 20 of the application as filed; claim 30 is claim 2 of the application as filed; claims 31-33 are claims 12-14 of the application as filed; claim 35 is claim 15 as filed; and claims 34 and 36 are based on claim 16 as filed.

The restriction requirement

During prosecution of the application prior to the filing of the RCE, the Examiner had required election of a species of the insulin receptor-activating compound (as claimed in original claim 1), and Applicants had elected the method using the compounds of formula I, and specifically the compound of claim 18. That restriction requirement was maintained, and claims 1-2 (in part), 12-17 (in part), 6-11, 19, and 20 were withdrawn from consideration. New claims 21-36 are all drawn to the originally elected species or subspecies thereof, and are therefore believed in compliance with the restriction requirement.

The objection to the specification

In the response to the first Office Action, claims 3-5 had been rejected under 35 USC 112, ¶2, for indefiniteness for use of the term "each Y is a non-interfering substituent". In the Response mailed 4 April 2003, Applicants had amended claim 3 to define Y by specific substituents, and had referred to WO 00/71506 (incorporated by reference) as the source for the amendment. In the final rejection dated 18 June 2003, the Examiner stated that the incorporation by reference of essential material was improper, and had required amendment of the disclosure to include the material incorporated by reference. This objection is respectfully traversed.

Although Applicants had originally referred, in the response mailed 4 April 2003, to WO 00/71506 as the source of the amendment to define Y, and accept that if the material incorporated by reference were considered essential they would have been required to amend the disclosure of the application to include the material incorporated by reference, Applicants note that they may also refer to the '279 application as the source of the amendment. The incorporation by reference of the '279 application is seen at page 3, lines 28-29; and this application has been patented as the '998 patent. Applicants submit that, even if the material incorporated by reference is considered essential, because the material is incorporated by reference to a US patent, the application referred to having issued as a patent after the filing of this application, incorporation by reference is proper (MPEP 608.01(p) I.A.1., second paragraph – the Office has a copy of the '998 patent), so that no amendment of the disclosure to include the material incorporated by reference is required.

Withdrawal of the objection is respectfully requested.

The 35 USC 112, ¶1 rejection

Claims 3-5 were rejected under 35 USC 112, ¶1 for failure to comply with the written description requirement, with the Examiner asserting that these claims contain subject matter not described in the application as filed, based on the lack of definition of the substituent Y in the specification. This rejection is respectfully traversed as to new claims 21-36.

From the discussion of the amendment and of the objection to the specification above, Applicants submit that claims 21-36 comply with the written description requirement because they find support in the application as filed, both directly in the application itself and in the '279 application (the '998 patent) which is incorporated by reference.

Withdrawal of the rejection is respectfully requested.

The double patenting rejection

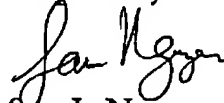
Claims 1-5 and 12-18 were rejected under the doctrine of obviousness-type double patenting over claims 29-33 of US Patent No. 6,458,998.

Applicants are submitting with this response a terminal disclaimer over US Patent No. 6,458,998; and respectfully request withdrawal of the rejection in view of the terminal disclaimer.

Conclusion

Entry of the RCE, the amendment, and the terminal disclaimer; and re-examination, reconsideration, and allowance of claims 21-36 are respectfully requested.

Respectfully submitted,



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